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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/701,831 | 08/31/2001 | Jean-Marc Boutillier | 2988-661 | 9853 |

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EXAMINER

MULLIS, JEFFREY C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1711 | 13 |

DATE MAILED: 09/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

ms-13

Office Action Summary

Application No.

09/701,831

Applicant(s)

BOUTILLIER, JEAN-MARC

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 472.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "in the polymerization mixture before phase inversion" makes no sense in the context of claim 1 since no phase inversion is mentioned up until lines 13-14 of claim 1 and therefore the term "phase inversion" lacks antecedent basis within this claim and it is unclear if phase inversion is a required feature of claim 1.

The term "section(s)" as recited in the claims makes no sense in the context of these claims or at the very least is unclear as to what sections are being referred to since it is not stated what the sections pertain to.

The term "equivalent diameter" is not art recognized and is therefore unclear.

The term "type" renders the claims unclear since it cannot objectively be determined when one feature is of the type of another.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

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on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 14-22, 24-25 and 27-32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bueschl et al. (EP 259623).

Bueschl et al. disclose a process in which Irganox 1076 is combined with polybutadiene, styrene, 0.1% BPO and 0.12% Irganox and then polymerized. Note patentees' Examples starting on page 12. Note that applicant's specification at page 15 lines 6-10 defines "the family of stable free radicals includes in particular the compounds acting as radical polymerization inhibitors for storing monomers". Therefore the Irganox 1076 of patentees embraces applicant's stable free radical.

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Claims 34-41 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Boutillier (USP 6,255,402).

See Example 2 in column 9 where polybutadiene is polymerized in the presence of TEMPO and a free radical initiator using similar concentrations to that disclosed by applicant's specification for obtaining his product.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a certified translation of said papers has not been made of record. See MPEP § 201.15.

Claims 1-9, 18-22, 24-25 and 27-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by DD 294493.

Note Example 1 where stable free radical and a free radical initiator are combined in the presence of rubber and styrene. Although no phase inversion takes place, it is not clear that the claims require such.

Claims 34-41 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nicol (USP 6,262,179).

See Figures 1 and 2 for particle size distributions which explicitly appear to be similar or the same as that of applicant except although there is some uncertainty due to the fact that a particle diameter is recorded only to the nearest 1/2 micron. In any case Figures 1 and 2 are based on Examples 1 and 2 at columns 5 and 6 of the patent and one and only one size distribution is defined by each example.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different

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whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Claims 1-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicol, cited above in view of Klatt et al. (DE 19637368).

Although there are no specific examples in Nicol in which free radical initiator is utilized, it is disclosed by patentees that free radical initiator may be used at applicant's level at column 4 lines 56-65 and column 3 lines 26-32.

Klatt et al. at page 9 lines 36-46 discloses that cases may be produced for objects such as computers. Klatt et al. also disclose that molding may take place by injection molding. Note that Klatt et al.'s composition may be an impact modified vinyl aromatic polymer.

With regard to the use of applicant's specific molecular weight and particle to size distribution and use of free radical initiator in combination with the stable free radical, there are no specific examples explicitly disclosed by the primary reference. However it would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to use applicant's particle size distribution and molecular weight distribution since the primary reference specifically discloses

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that such variables are result effective with regard to impact strength and gloss, etc. and with regard to use of free radical initiator such as taught by the primary reference and therefore use of such would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in the expectation that such an embodiment would be workable absent any showing of surprising or unexpected results.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

May 31, 2003